

REMARKS

Claims 55, 58, 59, 62, 64, 65, 70 and 72 have been canceled to further the prosecution of the remaining claims. Applicants maintain that the canceled claims satisfy the requirements of 35 U.S.C. § 112, first paragraph, and will pursue these claims in a continuation application. Claim 68 has not be canceled since it is believed to have been included with the claims rejected under 35 U.S.C. § 112, first paragraph, in error. Claim 68 defines a compound and not a method of treatment or pharmaceutical composition as do the other claims rejected under 35 U.S.C. § 112, first paragraph. No reasons have been given for rejecting compound claim 68 under 35 U.S.C. § 112, first paragraph.

Claim 71 has been amended and new dependent claims 90-92 have been added to further define preferred embodiments. Claims 93-95 have been added to define the compound within the commercial product Nexovar® with greater particularity. The new claims are supported by the exemplified compounds, such as compound 42, and the disclosure regarding pharmaceutically acceptable salts which appears on page 6, lines 13-28 of the specification.

Applicants acknowledge the withdrawal of the obviousness type double patenting rejections based on copending applications 10/361,858; 10/361,859; 10/308,187 and 10/895,985. The obviousness type double patenting rejections based on applications 09/948,915; 10/086,417; 10/042,203 and 09/993,647 are moot in that applicants have:

- a) canceled claim 12 of copending application 10/086,417;
- b) canceled claim 61 of copending application 09/948,915; and
- c) filed a terminal disclaimer in this application for any term extending beyond the term of Application No. 10/042,203, which issued as U.S. Patent No. 7,235,576 B1, and any term extending beyond the term of copending application 09/993,647, filed November 27, 2001.

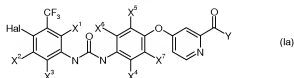
The terminal disclaimer identified above has been filed simultaneously with this reply. Copies of the amendments made in copending applications 10/086,417 and 09/948,915 have been provided herewith.

Applicants traverse the provisional obviousness-type double patenting rejection based on claims 1-15 of copending US Application No. 10/071,248. The independent claims

(Claims 1, 14 and 15) of copending US Application No. 10/071,248 are reproduced below to help demonstrate that the compounds claimed herein are patentably distinct from the compounds defined by these claims.

Claim 1 of copending US Application No. 10/071,248

A compound of formula (Ia)



wherein,

Y is NHR,

Hal is chlorine or bromine,

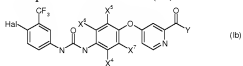
R is H, CH₃ or CH₂OH, and

X¹ to X⁷ are each, independently, H, OH or -OC(O)C₁-C₄ alkyl, or a salt or purified stereoisomer thereof,

with the proviso that at least one of X¹ to X⁷ is OH or -OC(O)C₁-C₄ alkyl.

Claim 14 of copending US Application No. 10/071,248

A compound of formula (Ib)



wherein,

Y is NHR,

Hal is chlorine or bromine,

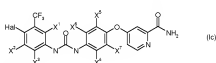
R is H, CH₃ or CH₂OH, and

X⁴ to X⁷ are each, independently, H, OH or -OC(O)C₁-C₄ alkyl, or a salt or purified stereoisomer thereof,

with the proviso that at least one of X⁴ to X⁷ is OH or -OC(O)C₁-C₄ alkyl.

Claim 15 of copending US Application No. 10/071,248

A compound of formula (Ic)



wherein,

Hal is chlorine or bromine, and

X¹ to X⁷ are each, independently, H, OH or -OC(O)C₁-C₄ alkyl, or a salt or purified stereoisomer thereof,

with the proviso that at least one of X¹ to X⁷ is OH or -OC(O)C₁-C₄ alkyl.

As can be seen from the language underlined and in bold, the compounds of these claims require at least one "OH" substituent or a "-OC(O)C₁-C₄ alkyl" substituent. The compounds claimed herein do not have hydroxy or ester groups at the positions corresponding to X¹ to X⁷ of formula I within US Application No. 10/071,248 and the examiner has not provided any reason why one skilled in the art would eliminate the **required** substituents of the compounds claimed in US 10/071,248 to arrive at the compounds claimed herein. Therefore, applicants submit the subject matter of claims 1-15 of copending US Application No. 10/071,248 does not render the claims herein obvious. The claims herein are patentably distinct from the subject matter of claims 1-15 of copending US Application No. 10/071,248 such that the obviousness type double patenting rejection based on these claims should be withdrawn.

In view of the above remarks, favorable reconsideration is courteously requested. If there are any remaining issues which could be expedited by a telephone conference, the Examiner is courteously invited to telephone counsel at the number indicated below.

The Commissioner is hereby authorized to charge any fees associated with this response or credit any overpayment to Deposit Account No. 13-3402.

Respectfully submitted,

/Richard J. Traverso/
Richard J. Traverso, Reg. No. 30,595
Attorney for Applicant(s)

MILLEN, WHITE, ZELANO
& BRANIGAN, P.C.
Arlington Courthouse Plaza 1, Suite 1400
2200 Clarendon Boulevard
Arlington, Virginia 22201
Telephone: (703) 243-6333
Facsimile: (703) 243-6410

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